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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,308	03/18/2004	Patricia J. Horst	502611-CIP	5768

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EXAMINER	
REESE, DAVID C	
ART UNIT	PAPER NUMBER
3677	

NOTIFICATION DATE	DELIVERY MODE
01/26/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/803,308	HORST ET AL.	
	Examiner	Art Unit	
	David C. Reese	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 August 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-16,18 and 21-43* is/are pending in the application.

4a) Of the above claim(s) *2,4,7,8,10,12,15,16,18,21-29,36,39 and 40* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3, 9, 11, 30-35, and 40-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

THIS FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 8/6/2008.

- Claims 1, 17, and 19-20 are canceled.
- Claims 41-43 were added.
- Claims 3, 30, and 35 were amended.
- Claims 2, 4, 7-8, 10, 12, 15-16, 18, 21-29, 36, and 39-40 are withdrawn.
- Claims 2-16, 18, 21-43 are pending.

Claim Objections

[1] Claims 9 and 11 are objected to because of the following informalities: "underlying substrate" is not found in depending claim 3. It is apparent that it should read as "underlying floor covering". Appropriate correction is required.

Claim Rejections - 35 USC § 112

[2] The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[3] Claim 43 recites the limitation "the carpet pad" in the instant claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

[4] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[5] Claims 3, 9, 11, 30-35, 37-38, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliott (US 1,782,293) in view of Cundall (GB 2,113,993) and in further view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

Regarding claims 3, 30, and 41, Elliott discloses an apparatus (see fig. 2) for securing a movable floor covering (A) to a floor, the apparatus comprising:

a substantially flat and planar central base member body (7) adapted to be placed between a movable floor covering and the floor covering;

the central base member body (7) having an upper surface (top of 7) thereof adapted for attachment thereto of the movable floor covering (A), and a lower surface (1) thereof having a lone downwardly extending threaded (4) spike (1) that [is adapted to pass completely through the layer of pile and threadably (via 4) engage the backing of the underlying floor covering for securing the apparatus to the underlying floor covering as the central base member of the apparatus is rotated to screw the threaded spike through the backing]. Further, as articulated in claim 30, Elliott also discloses of the spike being adapted for rotatably penetrating as rotational torque is applied to the central base manner to screw the threaded spike through the substrate.

Though Elliott states that the fastener is used to detachably hold a carpet or rug in place upon a floor, and that the same may be used for other purposes (lines 45-47), Elliott does not

expressly disclose of an underlying floor covering (between the movable floor and the floor) supported on the floor, where the underlying floor covering has a layer of pile and a backing with the pile attached to and extending upward from the backing of the underlying floor covering opposite the floor. Cundall discloses a fastening apparatus similar to that of Elliott including a central base member body and a downwardly extending spike used to fasten a movable floor (mat) covering to a floor. In addition, Cundall further teaches an underlying floor covering (carpet) comprising a layer of pile (see abstract, also examiner notes that carpet that one of ordinary skill in the art would realize that carpet/pile comprises backing) supporting the floor between the movable floor (mat) and the floor. It would have been obvious to one of ordinary skill in the art, having the disclosures of Elliott and Cundall before him at the time the invention was made, to add an underlying floor such as carpet with pile between the movable floor covering and the floor of Elliott, as in Cundall. One would have been motivated to make such a combination because one would want to use the fastener to hold a mat or rug to a carpet and floor, as taught by Cundall for user design and preference. Further, it would have been obvious to a person of ordinary skill in the art to have used the fastener in a configuration with a mat or rug and carpet and floor as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp. In turn, because a fastener used with an underlying floor, movable floor and floor has as claimed has the properties predicted by the prior art of Cundall, it would have been obvious to make the such an alteration in order to gain the commonly understood benefits and applications of such an adaptation and/or modification.

Regarding claim 9, Elliott in view of Cundall teach wherein the single downwardly extending spike (1) is [adapted for penetrating completely through the backing of the underlying substrate].

Re: Claim 11, Elliott in view of Cundall teach wherein the backing of the underlying substrate defines a lower surface thereof, and the single downwardly extending threaded spike includes a thread on an outer surface thereof adapted for engaging the lower surface of the backing of the underlying substrate.

Re: Claim 31, Elliott in view of Cundall teach wherein the downwardly extending spike (1) includes helical thread on an outer surface thereof [for engaging the lower surface of the backing of the carpet].

Re: Claim 32, Elliott in view of Cundall teach wherein:

the backing of the carpet [is adapted to rest upon an upper surface of a carpet pad disposed between the carpet and a floor]*; and

the downwardly extending threaded spike (1) has a length thereof [configured for extending completely through the pile and backing of the carpet and partially into but not through the carpet pad]*.

Examiner's note: the above statement in brackets is an example of intended use, the prior art must only be capable of performing said functional recitation to be applicable, and in the instant claim, the threaded spike of Elliott in view of Cundall is indeed capable of extending partially into a carpet pad adapted to rest between the carpet and the floor. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed

does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 34 and 33, Elliott in view of Cundall teach that the central base member includes one or more torque receiving elements, wherein said torque receiving elements comprise of one ore more grasping elements for grasping and applying torque to the apparatus.

As for claims 5, 6, 13, 14, and 37-38, Elliott lacks the upper surface of the central base member including an adhesive for bonding, wherein said adhesive is covered by a removable protective member that is peeled off to expose the adhesive. Cundall discloses a similar invention, where its upper surface (5) of the central base member includes an adhesive for bonding, wherein said adhesive is covered by a removable protective member (8) that is peeled off to expose the adhesive. (See fig. 4, lines 55-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to further modify the anchor system of Elliott as modified by Cundall as set forth above to have included the teaching of the adhesive on the upper surface of the central base member in Meader and Elliot in view of Cundall in order to provide an alternative means to for the apparatus to affix to a rug above said apparatus. Further, it would have been obvious to a person of ordinary skill in the art to have used adhesive to connect the top of the fastener to the mat/rug as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp. In turn, because a adhesive (covered by a removable protective member) used to connect the fastener to a rug/mat as claimed has the properties predicted by the prior art of Cundall, it would have been obvious to make or use such alternative means in order to gain the commonly understood benefits and applications of such an adaptation and/or modification.

With regard to claim 35, Elliott in view of Cundall lacks that the threaded spike is rotated solely by application of torque to the body of the apparatus. Note that it has been held to be within the general skill of a worker in the art to make plural parts (the threaded spike, 1, and body of apparatus, 7) unitary as a matter of obvious engineering choice. *In re Larson, 144 USPQ 347 (CCPA 1965); In re Lockart, 90 USPQ 214 (CCPA 1951)*, consequently allowing the threaded spike to be rotated solely by application of torque to the body of the apparatus.

Re claim 42, Elliott in view of Cundall teaches wherein the threaded spike (1) does not threadably engage the floor (in view of Cundall).

Response to Arguments

[6] Applicant's amendment and remarks filed 8/6/2008 regarding rejections under 35 U.S.C. 103 have been fully considered. However, upon further consideration of the amended claims, a new ground(s) of rejection is made in view of Elliott (US 1,782,293) in view of Cundall (GB 2,113,993) in further view of case law. Consequently, all arguments are considered moot to said new grounds of rejection.

Conclusion

[7] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

[8] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese

/D. C. R./
Examiner, Art Unit 3677

/Victor Batson/
Supervisory Patent Examiner, Art Unit 3677